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MAR 1 2 2008

OFFICE OF PETITIONS

In re Application of:	:	
Kim et al.	:	
Application No. 10/651690	:	DECISION GRANTING
Filing or 371(c) Date: 08/28/2003	:	PETITION UNDER
Title of Invention:	:	37 CFR § 1.183
DIAGNOSIS AND TREATMENT OF	:	
INFERTILITY	:	

This Decision is in response to the "Petition Under 37 C.F.R. § 1.183 to Suspend the rules Requiring the Signature of all Inventors for a Declaration of Combined Inventorship Under 37 C.F.R. § 1.131," filed December 26, 2007.

The petition is dismissed.

The application as-filed identified three inventors as the inventive entity: Joanne Young Hee Kwak-Kim, Alan E. Beer and Alice Gilman-Sachs. A final Office action was mailed on November 29, 2007. Applicant filed a petition to revive the application under 37 CFR 1.137(b), along with a Request for Continued Examination ("RCE") and the Combined Declaration of Joint Inventors Under 37 C.F.R. § 1.131, executed by co-inventors Young Hee Kwak-Kim and Alice Gilman-Sachs only. In a non-final Office action mailed June 27, 2007, Applicant was advised that, "[u]pon consultation with the Office of Legal Affairs, it was determined that a statement under 37 CFR 1.131 that a coinventor is dead is not sufficient to establish the death of the coinventor in the prosecution history." Applicant was advised that, since no rule exactly fits the situation, Applicant should file a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.131 to the extent that it requires the signature of inventor Beers, indicating that inventor Beer is deceased.

The present petition

Applicant files the present petition and states that the inventor Beer is deceased, and includes Supplemental Declarations of inventors Young Hee Kwak-Kim and Alice Gilman-Sachs, stating that inventor Beer is deceased. No other evidence to support the assertion that inventor Beer is deceased has been provided.

The MPEP 715.04, Swearing back of Reference, Affidavit or Declarant Under 37 CFR 1.131, provides

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
- (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims.

Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37 CFR 1.63) is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, the affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131. Proof that the non-signing inventor is unavailable or cannot be found similar to the proof required for a petition under 37 CFR 1.47 must be submitted with the petition under 37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP § 1002.02(b)).

This section states that a party qualified under 37 CFR 1.42, 1.43 or 1.47 may make the affidavit when it is not possible to produce the affidavit or declaration of the inventor, and that waiver of the signature requirement of the unavailable inventor may be demonstrated by proof similar to that required in a petition under 37 CFR 1.47..

In discussing waiver requirements under 37 CFR 1.183, the Office is guided by proof similar to that required when an Applicant is unavailable. In this instance, Applicant asserts that the inventor is deceased. 37 CFR 1.42 states: "Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

The MPEP 409.01, Death of Inventor, proves instructive. It states:

When a joint inventor of a pro se application dies after filing the application, the living joint inventor(s) must submit proof that the other joint inventor is dead. Upon submission of such proof, only the signatures of the living joint inventors are required on the papers filed with the USPTO if the legal representative of the deceased inventor does not intervene. If the legal representative of the deceased inventor wishes to intervene, the legal representative must submit an oath or declaration in compliance with 37 CFR 1.63 and 1.64 (e.g., stating that he or she is the legal representative of the deceased inventor and his or her residence, citizenship and post office address). Once the legal representative of the deceased inventor intervenes in the pro se application, the signatures of the living joint inventors and the legal representative are required on the papers filed with the USPTO.

MPEP 409.01

This section explains that when joint inventors are attempting to file papers in an application where one of the joint inventors in the application has died, before the papers may be accepted, proof that the other inventor is dead is required.

As stated supra, in a non-final Office action mailed June 27, 2007, Applicant was advised that, “[u]pon consultation with the Office of Legal Affairs, it was determined that a statement under 37 CFR 1.131 that a coinventor is dead is not sufficient to establish the death of the coinventor in the prosecution history.” However, in the present petition, Applicant has not submitted any proof other than a statement in the petition, that the nonsigning inventor is dead, above that which was previously submitted.

Conclusion

Applicant must submit proof that the other joint inventor is dead. Acceptable proof would consist of a copy of a Death Certificate, or a statement from the legal representative of the deceased inventor, that the inventor is deceased¹. The petition is dismissed without prejudice.

Further correspondence with respect to this matter should be addressed as follows:

¹ In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with 37 CFR 1.42.

Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator. The heirs should identify themselves as the legal representative of the deceased inventor in the oath or declaration submitted pursuant to 37 CFR 1.63 and 1.64.

409.01(b) Proof of Authority of Administrator or Executor

The Office no longer requires proof of authority of the legal representative of a deceased or incapacitated inventor. Although the Office does not require proof of authority to be filed, any person acting as a legal representative of a deceased or incapacitated inventor should ensure that he or she is properly acting in such a capacity.

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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


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